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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/334,617 | 06/17/1999 | YOSHIHIRO IDA | P18051 | 5530 |

7055 7590 07/31/2003

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

GIBBS, HEATHER D

| ART UNIT | PAPER NUMBER |
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2622

DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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Office Action Summary

Application No.

09/334,617

Applicant(s)

IDA ET AL.

Examiner

Heather D Gibbs

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 11-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 14-23 is/are rejected.
- 7) ☒ Claim(s) 2,15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Objections

1. Claims 2 and 15 are objected to because of the following informalities:
Missing word(s), Insert [is] after "communication terminal specific information".
Appropriate correction is required.

Response to Amendment

2. Applicant's amendment was received on 04/29/03, and has been entered and made of record. Currently, Claims 1-10 and 14-23 are pending. Claims 11-13 have been withdrawn from consideration.

Claim Rejections - 35 USC § 112

3. Claim 5 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "the other data" in Line 9 on Page 26. Claim 17 recites the limitation "the other server" in Lines 15-16 on Page 29. There are insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

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matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,10 and 14-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al (US 6,266,160) in view of Ohto et al (US 5,864,673).

Regarding claim 1, Saito et al (US 6,266,160) discloses a server apparatus comprising: means for receiving a mail from a communication terminal (Col 3 Lines 45-59); means for analyzing the received mail so as to extract capability information included in said mail (Col 4 Lines 60-63).

Saito does not explicitly teach of capability information storing means for storing said capability information extracted by said extracting means to be made to correspond to communication terminal specific information specifying a communication terminal.

Ohto et al (US 5,864,673) teaches of a capability information storing means for storing said capability information extracted by said extracting means to be made to correspond to communication terminal specific information specifying a communication terminal (Col 24 Lines 58-67 and Col 25 Lines 1-29 and Fig 29).

Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine Ohto's capability storing means in the server apparatus of Saito. Saito et al server apparatus would easily be modified to include Ohto et al capability storing means to facilitate the storage of information and due to the cumulative features of the systems, making them additive in nature.

Claims 10 and 14 are analogous to claim 1 and hence are rejected for the same reasoning.

Considering claims 2, which is analogous to claim 15, Saito teaches wherein said communication terminal specific information a mail address, which is allocated to the communication terminal, is an ID number, a telephone number, a name, URL, or an IP address.

Regarding claim 3, Ohto teaches of means for recognizing communication terminal specific information specifying the communication terminal of a recipient of a mail to which an image file is attached so as to obtain recipient's capability information corresponding to said communication terminal specific information from the content which said capability information storing means stores; and converting means for converting said image file to an image file suitable for said recipient's capability information (Col 18 Lines 19-24 and Col 20 Lines 30-41).

It would have been obvious to one of ordinary skill in the art to utilize Ohto's recognition and converting means in the system of Saito. Saito's system would easily be modified to include Ohto's communication means since it shows that media attribute stored can be converted.

Regarding claim 4, Ohto teaches of an apparatus that further comprises means for transferring data to the other server so as to register data when the volume of the image file converted by said converting means is more than a default value (Col 23 Lines 23-67 and Col 24 Lines 1-15)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include Ohto's transferring means in the apparatus of Saito. Saito's apparatus would be easily modified to include Ohto's transferring means to facilitate any information that exceeds the predetermined threshold.

Regarding claim 6, Ohto teaches of an apparatus that further comprises means for recognizing communication terminal specific information specifying the communication terminal of a recipient of a mail to which an image file is attached so as to obtain recipient's capability information corresponding to said communication terminal specific information from the content which said capability information storing means stores; and means for determining whether or not said image file is suitable for said recipient's capability information so as to transfer said image file to the other server and register said image file when said image file is not suitable for said recipients' capability information (Col 18 Lines 19-24 and Col 20 Lines 30-41).

It would have been obvious to one of ordinary skill in the art to utilize Ohto's recognition and converting means in the system of Saito. Saito's system would easily be modified to include Ohto's communication means since it shows that media attribute stored can be determined and then converted.

Regarding claim 7, Ohto teaches of an apparatus that further comprises means for transmitting a mail notifying that data has been transferred to the other data to the recipient of the mail to which the image file is attached so as to notify the transfer result (Col 15 Lines 44-65).

It would have been obvious to one of ordinary skill in the art to combine Ohto's mail transmission in the apparatus of Saito. Saito's apparatus would easily be modified to include notification means when transmitting an email to verify that the mail has been transferred successfully.

Regarding claim 8, Ohto teaches of updating the content, which said capability information storing means stores, to newly obtained capability information

when said capability information storing means receives the mail including capability information of the communication terminal which has already stored capability information (Col 15 Lines 21-36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include Ohto's update means in the apparatus of Saito. Saito's apparatus would be easily modified to include Ohto's update means as a way of maintaining current information before transmission is completed.

Regarding claim 9, Ohto teaches wherein said capability information storing means is a table for storing capability information to be made to correspond to communication terminal specific information (Col 14 Lines 44-50, and Col 16 Lines 18-37, and Fig 11).

It would have been obvious to one of ordinary skill in the art to combine Ohto's capability information storage table in the apparatus of Saito. Saito's apparatus would be easily modified to include a capability information storage table so that the storage information would be contained in an organized manner. Claims 16,18-23 are rejected on the same grounds as stated above. Claims 16,18-21 disclose the method as rejected in claims 3-4,6-9. Claims 22-23 are rejected also on the same grounds because it is inherent to have a computer-readable storage medium storing a computer-executable program code therein.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Maeda (US 6,437,873) Internet Facsimile Apparatus, Network

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System having the Same, and Method of Controlling the Same; Toyoda et al (US 5,881,233) Facsimile Mail Apparatus; Aziz et al (US 6,119,234) Method and Apparatus for Client-Host Communication Over a Computer Network; Feder (US 5,872,845) Method and Apparatus for Interfacing Fax Machines to Digital Communication Networks.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather D Gibbs whose telephone number is 703-306-4152. The examiner can normally be reached on M-F 8AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703-305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

HDG

hdg

July 14, 2003

Heather D Gibbs

Examiner

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EDWARD COLES

SUPERVISORY PATENT EXAMINER

TECHNOLOGY CENTER 2600